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LOEWE, ROBERT S				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/522,578

**Applicant(s)**

POUCHELON ET AL.

**Examiner**

ROBERT LOEWE

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 1/28/05

## **DETAILED ACTION**

### ***International Search Report***

EP-543401, cited on the international search report as an "X" reference, was not relied upon since it does not explicitly teach the required viscosity of the procured composition of instant claim 13, and as such, does not anticipate all limitations of this claim.

EP-553840, cited on the international search report as an "X" reference, was not relied upon since it does not explicitly teach the required viscosity of the procured composition of instant claim 13, and as such, does not anticipate all limitations of this claim.

EP-764702, cited on the international search report as an "X" reference, was not relied upon since it does not explicitly teach the required viscosity of the procured composition of instant claim 13, and as such, does not anticipate all limitations of this claim.

### ***Claim Interpretation***

Claim 13 recites a silicone composition "for the treatment of fibrous material". However, this amounts to no more than a statement of intended use. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. In the instant case, the above limitation amounts to no more than an intended use which is deemed not to further limit the claim. See MPEP 2106 (II) C.

Claim 14 refers to the composition of claim 13 as being fluid. For purposes of further examination, it will be interpreted by the Examiner that claim 14 is directed to the pre-cured polysiloxane composition.

### ***Claim Objections***

Claim 13 is objected to because of the use of "it" in the claim. Specifically "it has a dynamic viscosity..." and "it has, after complete crosslinking..." For purposes of further examination, "it" will be interpreted as the silicone composition. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 13-18, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujiki et al. (US Pat. 6,387,520; equivalent to EP-1078823 which is cited on the international search report as an "X" reference).

Claims 13-14: Fujiki et al. teaches a solvent-free liquid/fluid silicone rubber coating composition (abstract) comprising (A) an organopolysiloxane having at least two alkenyl groups, (B) an organohydrogenpolysiloxane having at least two Si-H groups, (C) a platinum-based catalyst, and (D) an adhesive agent/adhesion promoter (abstract). Fujiki et al. further teaches

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that the organohydrogenpolysiloxane has six Si-H groups (8:40). Fujiki et al. further teaches that the viscosity of the composition before curing is **preferably** from 1,000 to 10,000 cP (1,000 to 10,000 mPa·s), which substantially encompasses the range of instant claim 13. Fujiki et al. explicitly teaches a composition which has a pre-cure viscosity of 4,500 cP (4,500 mPa·s, example 1). While Fujiki et al. does not explicitly teach the Shore A hardness, % elongation or tensile strengths of the cured compositions, it nevertheless follows that Fujiki et al. teaches all of the claimed ingredients. Therefore, the final physical properties of the cured compositions taught by Fujiki et al. would inherently possess a Shore hardness of at least 2, a tensile strength of at least 0.5 N/mm, and an elongation at break of at least 50%. Further, it is well known by a person having ordinary skill in the art that the vast majority of cured silicone compositions would satisfy the physical property requirements of instant claim 13.

Claim 15: Because Fujiki et al. teaches all of the claimed ingredients, it inherently follows that the compositions taught by Fujiki et al. would be capable of impregnating a fibrous material right to the core followed by crosslinking to form a composite having a capillary rise time of less than 20 nm, as required by instant claim 15.

Claim 16: Fujiki et al. further teaches that the organopolysiloxane satisfies the structural limitations of instant claim 16 (2:24-3:28).

Claim 17: Fujiki et al. further teaches that the organohydrogenpolysiloxane satisfies the structural limitations of instant claim 17 (3:29-4:24).

Claim 18: Fujiki et al. further teaches that the mol ratio of the Si-H groups to all of the alkenyl groups in the composition is from 0.9 to 20, preferably from 0.9 to 5, which substantially encompasses the range of instant claim 18 (7:11-17).

Claim 20: Fujiki et al. further teaches an adhesion promoter (5:40-6:39), which can be added in amounts which satisfy the range of instant claim 20 (7:6-8 and example 1).

Claims 22 and 23: Fujiki et al. teaches an air bag fabric which is coated/impregnated with the composition of instant claim 13 and subsequently cured (abstract and 8:49-55).

Claim 24: Because Fujiki et al. teaches all of the claimed ingredients, it inherently follows that the compositions taught by Fujiki et al. would be capable of impregnating a fibrous material right to the core followed by crosslinking to form a composite having a capillary rise time of less than 20 nm, as required by instant claim 24.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiki et al. (US Pat. 6,387,520; equivalent to EP-1078823 which is cited on the international search report as an "X" reference) as applied to claim 13 above, further in view of Lorenzetti et al. (US Pat. 5,658,674).

Fujiki et al. teaches the composition of instant claim 13, as described above. Fujiki et al. does not teach that the adhesion promoter comprises vinyltrimethoxysilane, 3-glycidoxypolytrimethoxysilane and *tert*-butyl titanate. However, Lorenzetti et al. does teach an adhesion promoter composition consisting of the above three ingredients (4:33-35). Fujiki et al. and Lorenzetti et al. are combinable because they are from the same field of endeavor, namely, curable silicone compositions which are used to coat airbags. At the time of the invention, it would have been obvious to a person having ordinary skill in the art to employ the adhesion promoter combination of Lorenzetti et al. into the silicone compositions as taught by Fujiki et al. and would have been motivated to do so because Lorenzetti et al. teaches that the above combination of adhesion promoters yields exceptionally high performance levels in bonding to supports, such as airbags (2:66-3:4).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiki et al. (US Pat. 6,387,520; equivalent to EP-1078823 which is cited on the international search report as an "X" reference) as applied to claim 13 above.

Fujiki et al. teaches the composition of instant claim 13, as described above. Fujiki et al. does not explicitly teach that a two-component precursor system for the liquid silicone rubber composition of instant claim 13 can be employed. However, a person having ordinary skill in

the art recognizes that curable silicone compositions are of the one-part or two-part type. Owing to the fact that only two types of curable silicone rubber systems are generally available, selection of a two-part composition is obvious. Further, a person of ordinary skill would have been motivated to employ a two-part curable organopolysiloxane composition so as to improve storage stability.

Claims 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorenzetti et al. (US Pat. 5,658,674) in view of Fujiki et al. (US Pat. 6,387,520; equivalent to EP-1078823 which is cited on the international search report as an "X" reference).

Claims 13, 14 and 16-21: Lorenzetti et al. teaches a low-temperature curable polysiloxane composition comprising components (a), (b), (c), (d), (e), (f) and (g) of instant claim 13 (1:66-2:11; 2:40-62 and claims 1). Lorenzetti et al. further teaches that components (a) and (b) of instant claim 13 further satisfy the limitations of instant claims 16-18 (claims 10-12 of Lorenzetti et al.). Lorenzetti et al. further teaches all of the claimed limitations of the adhesion promoter (claims 1, 4 and 5 of Lorenzetti et al.). Lorenzetti et al. further teaches a two part composition as required by instant claim 21 (claim 13 of Lorenzetti et al.). Lorenzetti et al. further teaches air bag coatings comprising the composition of instant claim 13 (abstract). In summary, Lorenzetti et al. substantially teaches all of the claimed ingredients and amounts of the instant claims. The only claimed difference between the instant application and Lorenzetti et al. is the claimed viscosity range of instant claim 13. Lorenzetti et al. does not teach that the viscosity fall into the range of instant claim 13; rather Lorenzetti et al. teaches that the viscosity of the precured compositions be at least 10,000 mPa·s (8:13-15). However, Fujiki et al. teaches a curable



organopolysiloxane composition having a pre-cured viscosity of preferably 1,000 to 10,000 mPa-s, with an explicit teaching of a curable composition having a viscosity of 4,500 mPa-s (8:47-48). Lorenzetti et al. and Fujiki et al. are combinable because they are from the same field of endeavor, namely, curable silicone compositions which are used to coat airbags. At the time of the invention, it would have been obvious to a person having ordinary skill in the art to lower the pre-cured viscosity to within the range as taught by Fujiki et al. and use such viscosities in the compositions taught by Lorenzetti et al. and would have been motivated to do so because Fujiki et al. teaches that the curable composition does not require solvent and provides improved infiltration, adhesion and coating ability on a fabric such as an air bag fabric (8:11-16). Further, Fujiki et al. teaches that the pre-cured polysiloxane compositions most preferably have a viscosity which satisfies the limitation of instant claim 13 so as to improve blending and film-strength (3:16-22). Improved penetration of the pre-cured compositions of Lorenzetti et al. would be a desirable property given the teachings of Fujiki et al.

Claim 15: Because Lorenzetti et al., in view of Fujiki et al., teach all of the claimed ingredients, it inherently follows that the compositions taught by Lorenzetti et al. would be capable of impregnating a fibrous material right to the core followed by crosslinking to form a composite having a capillary rise time of less than 20 nm, as required by instant claim 15.

Claim 23: Lorenzetti et al. teaches an air bag fabric which is coated with the composition of instant claim 13 and subsequently cured (abstract and examples).

Claim 24: Because Lorenzetti et al., in view of Fujiki et al., teach all of the claimed ingredients, it inherently follows that the compositions taught by Lorenzetti et al. would be

capable of impregnating a fibrous material right to the core followed by crosslinking to form a composite having a capillary rise time of less than 20 nm, as required by instant claim 24.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13 and 16-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6, 9, 10, 11 and 17 of U.S. Patent No. 6,586,551. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant and the '551 patent claim a composition having ingredients (a), (b), (c), (d) and (g) according to instant claim 13 (claims 1-4, 6 and 11 of '551 patent and claims 13, 19 and 20 of instant application). Claims 8-10 of the '551 patent are

substantially similar to claims 16-18 of the instant application, respectively. Claim 13 of the '551 patent are substantially similar to claim 21 of the instant application.

Claims 13 and 16-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6, 9, 10, 11 and 17 of U.S. Patent No. 6,562,737. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant and the '737 patent claim a composition having ingredients (a), (b), (c), (d), (e), (g) and (h) according to instant claim 13 (claims 1, 8-11, 13 and 21 of the '737 patent and claims 13, 19 and 20). Component (h) of the instant application is not directed to any specific compound or polymer, but is simply any functional additive. Claims 18-20 of the '737 patent are substantially similar to claims 16-18 of the instant application, respectively. Claim 22 of the '737 patent is substantially similar to claim 21 of the instant application.

Claims 13 and 16-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6, 9, 10, 11 and 17 of U.S. Patent No. 5,783,311. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant and the '311 patent claim a composition having ingredients (a), (b), (c), (d), (e), (f) and (g) according to instant claim 13 (claims 1-4 and 7 of the '311 patent and claims 13, 19 and 20). Claims 9-11 of the '311 patent are substantially similar to claims 16-18 of the instant application, respectively. Claim 12 of the '311 patent is substantially similar to claim 21 of the instant application.

Claims 13 and 16-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 6, 9, 10, 11 and 17 of U.S. Patent No. 5,658,674. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant and the '674 patent claim a composition having ingredients (a), (b), (c), (d), (e), (f) and (g) according to instant claim 13 (claims 1-5 and 8 of the '674 patent and claims 13, 19 and 20). Claims 10-12 of the '674 patent are substantially similar to claims 16-18 of the instant application, respectively. Claim 13 of the '674 patent is substantially similar to claim 21 of the instant application.

#### ***Relevant Art Cited***

The prior art made of record and not relied upon but is considered pertinent to applicants disclosure can be found on the attached PTO-892 form.

#### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 5:30 AM to 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./

Examiner, Art Unit 1796

24-May-08

/Randy Gulakowski/

Supervisory Patent Examiner, Art Unit 1796